

DRAWING AMENDMENTS

A reference character 53, for a newly added element that was described in the original specification, has been amended to Fig. 3 of the drawings in red ink along with the new element. A drawing amendment approval request form is enclosed herewith, as pursuant to MPEP 608.02(v).

REMARKS-General

1. The newly drafted independent claim 22 incorporates all structural limitations of the original claim 1 and includes further limitations previously brought forth in the disclosure. No new matter has been included. All new claims 22-30 are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.
2. A formal drawing, Fig. 3, is submitted herewith to replace the corresponding original figure in file upon the approval of the proposed drawing correction of Figure 3.

Regarding to Rejection of Claims 2, 3, 5, 6, 9, 10, 12, 13 and 15 under 35USC102

3. The Examiner rejected claims 2 and 9 under 35USC102(a) as being anticipated by L'Hotel et al (US 5,261,552), and claims 2, 3, 5, 6, 9, 10, 12, 13 and 15 as being anticipated by JP 11-241822.
4. However, the L'Hotel and JP 822' patents and the instant invention are **not the same invention** according to the fact that the independent claims of the L'Hotel and JP 822' patents does not read upon the instant invention and the independent claim 22 of the instant invention does not read upon the L'Hotel and JP 822' patents too. Apparently, the instant invention, which discloses a lighter with hidden pivot joint, should not be the same invention as the L'Hotel and JP 822' patents which disclose a mounting structure of a lighter.
5. L'Hotel and JP 822' fail to anticipate the distinctive features of:
 - (i) the case having **two longitudinal grooves** indently formed along two **sidewalls of the edge port** (as claimed in newly drafted claim 22);
 - (ii) **a connector** having an upper recess portion fittingly receiving the protuberance of the upper cover (as claimed in newly drafted claim 22);

(iii) the connector being slid into the opening to firmly mount the connector to the case until the upper recess portion of the connector sits on an edge of the opening (as claimed in newly drafted claim 22);

(iv) **two sidewalls of the connector** are shaped and sized to fittingly engage with the longitudinal grooves respectively so as to minimize **the thickness of the case side edge** of the case (as claimed in newly drafted claim 22);

(v) the connecting device only containing a hole on the protuberance, two transverse holes on the connector and a bolt to pivotally connect the protuberance of the upper cover the said connector at the recess portion thereof (as claimed in newly drafted claim 22); and

(vi) the connecting device being hidden within the case side edge of the case at a position below the upper edge of the case so as to pivotally connect the upper cover with the case as claimed in newly drafted claim 22).

6. Accordingly, L'Hotel merely discloses, in column 2, lines 46-56, a joint comprises a tenon 3 integral with the lid and engaging into a slot 4 provided in the wall of the case, wherein the tenon 3 carries two projecting pins 5 and two indentations 6 are formed at the slot 4 for the projecting pins 5 engaging therewith. L'Hotel never mentions any connector having a recess portion to pivotally connect to the tenon 3 via the connecting device and slidably engaging with the case. In addition, in column 3, lines 8-20, L'Hotel merely teaches a snap connection is provided to keep the lid in the closed position wherein in order to remove the lid, it is necessary to cause it to pivot about the pin 5 so as to break the snap connection. It is clearly the mounting structure of L'Hotel is different from the structure of the instant invention that the **connector** is not only pivotally connected to the upper cover but also slidably engaged with the case so as to embed the connecting device within the case side edge of the case. Furthermore, L'Hotel never discloses any longitudinal grooves to receive the tenon 3 to minimize the thickness of the case. As shown in Fig. 4 of L'Hotel, the thickness of the case must be increased in order to securely receive the tenon 3 of the lid.

7. JP 822', on the other hand, merely discloses a lighter which comprises a lighter case 1, a cover member 4 mounted on the lighter case 1, and a cap member 9. The advantage of JP 822' lighter is to allow the cap attachment to the lighter without

enabling the legs to reach the lighter case. Therefore, the cover member 4 is used as an adapter to lift up the cap attachment from the lighter case 1 such that the leg 10 of the cap member 9 is pivotally moved within the cover member 4. However, the main objective of the instant invention is to provide a pivot hinge pivotally connecting the upper cover with the case, wherein the pivot hinge (connecting device) is protected within the case since the pivot hinge is hidden in the case. No cover member 4 is needed in order to achieve the main objective of the instant invention.

8. JP 822' further a supporting member 11 having an upper portion pivotally connected to the cap member 9 via a first supporting axle 12 and a bottom portion connected to the cover member 4 via a second supporting axle 17. In other words, the supporting member 11 requires two supporting axles 12, 17 in order to pivotally connect the cap member 9 on the cover member 4. Therefore, the supporting member 11 is secured at the cover member 9 via the second supporting axle 17. It is clearly that JP 822' fails to anticipate the **connector** is not only pivotally connected to the upper cover but also slidably engaged with the case so as to embed the connecting device within the case side edge of the case. Furthermore, JP 822' never discloses any longitudinal groove to receive the supporting 11 to minimize the thickness of the cover member 4. As shown in Fig. 4 of JP 822', the thickness of the cover member 9 must be increased in order to securely receive the supporting member 11.

Response to Rejection of Claims 4, 7, 8, 11, and 14-18 under 35USC103

9. The Examiner rejected claims 4, 7, 8, 11, and 14-18 over JP 11-241822 in view of Newton (US 3,615,035). Pursuant to 35 U.S.C. 103:

“(a) A patent may not be obtained though the invention is **not identically** disclosed or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

10. In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)~(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

11. In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and JP 822' which is qualified as prior art of the instant invention under 35USC102(a) are obvious in view of Newton at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

12. However, as recited above, JP 822' merely discloses a lighter which comprises a lighter case 1, a cover member 4 mounted on the lighter case 1, and a cap member 9. Therefore, the difference between JP 822' and the instant invention as claimed in claims 22 to 30 is not limited to the disclosure of "pivot hinge", but includes the above distinctive features (i) to (vi). In addition, regarding to claims 23 to 30, the instant invention further contains the following distinctive features:

(vii) the connector having an inner side and an outer side having a width larger than a width of the inner side to form the two sidewalls of the connector extending in **an inclined manner to fit into the two longitudinal grooves** respectively so as to minimize the thickness of the side edge of the case when the connector is slidably engaged with the case (as claimed in claim 23);

(viii) each of the transverse holes being a through hole transversely formed on the connector at a position close to the outer side thereof to strengthen a pivotal connection between the protuberance of the upper cover and the connector through the bolt (as claimed in claim 24);

(ix) the thickness of the case side edge of the case being substantially **larger** than a thickness of the connector such that when the connector is received in the edge port, the connecting device is embedded within the case side edge of the case in a hidden manner (as claimed in claims 25 to 27); and

- (x) the thickness of the connector having a range from 1.0mm to 11mm.

13. Accordingly, JP 822' never mentions any inclined sidewall of the connector in order to fit into the longitudinal groove of the edge port. It is worth to mention that the **inclined sidewalls** of the connector substantially increase the contacting areas with the longitudinal grooves **not only to securely mount the connector within the edge port but also to minimize the thickness of the case.**

14. Newton, on the other hand, teaches a dovetailed tongue and a dove-tailed groove for the tongue engaging therewith. However, Newton fails to teaches the hinge unit is in a hidden manner that when the tongue is engaged with the groove. In addition, the tongue-groove engagement taught by Newton does not minimize the thickness of the tray part or the lid part of the container.

15. The applicant respectfully submits that the invention must be considered as a whole and there must be something in the reference that suggests the combination or the modification. See Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984) ("The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination"), In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") In re Laskowski, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989), ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.")

16. Examiner alleges that the thickness of the connector would depend on numerous design concern, the thickness in the range stated in applicant's claims can be viewed as nothing more than a mere matter of choice in design absent the showing of any new or unexpected results produced therefrom over the prior art of record. The applicant respectfully submits that since the connector of the instant invention has two inclined sidewalls to fit into the longitudinal grooves of the edge port respectively, the thickness of the connector can be substantially reduced without weakening the engagement

between the connector and the case. Furthermore, the thickness of the connector can be further reduced by positioning the transverse close to the outer side of the connector to strengthen a pivotal connection between the protuberance of the upper cover and the connector through the bolt. Having such thickness of the connector, the thickness of the case can be reduced to minimize the overall size and weight of the lighter. Therefore, the applicant respectfully submits the unexpected result of reducing the thickness of the case is achieved by the thickness of the connector which is considered as one of the subject matters to directly affect the thickness of the case.

17. In the present case, there is no such suggestion. In any case, even combining JP 822' and Newton would not provide the invention as claimed -- a clear indicia of nonobviousness. Ex parte Schwartz, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992), ("Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed.").

18. Applicant believes that neither JP 822' nor Newton, separately or in combination, suggest or make any mention whatsoever of having two inclined sidewalls of the connector to fit into the longitudinal grooves of the edge portion respectively as recited in claims 22-30.

19. Applicant believes that for all of the foregoing reasons, all of the claims are in condition for allowance and such action is respectfully requested.

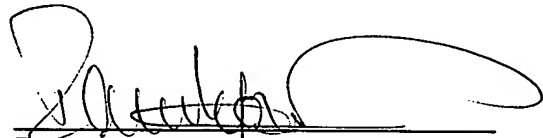
The Cited but Non-Applied References

20. The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

21. In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the objection are requested. Allowance of claims 22-30 at an early date is solicited.

22. Should the Examiner believe that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this corresponding is being deposited with the United States Postal Service by First Class Mail, with sufficient postage, in an envelope addressed to "Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: 07 / 20 / 2005

Signature: 
Person Signing: Raymond Y. Chan

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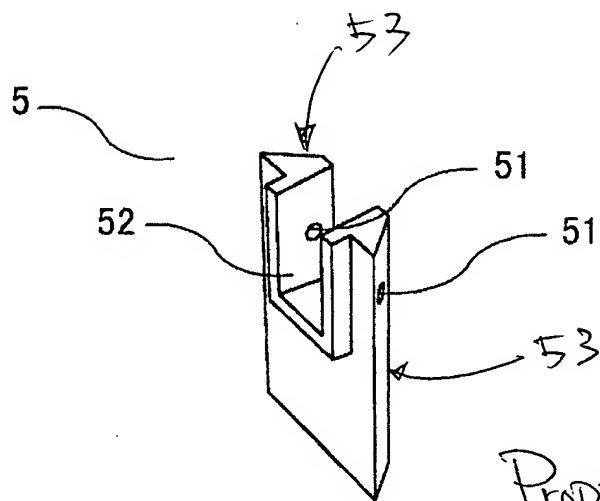


FIG. 3

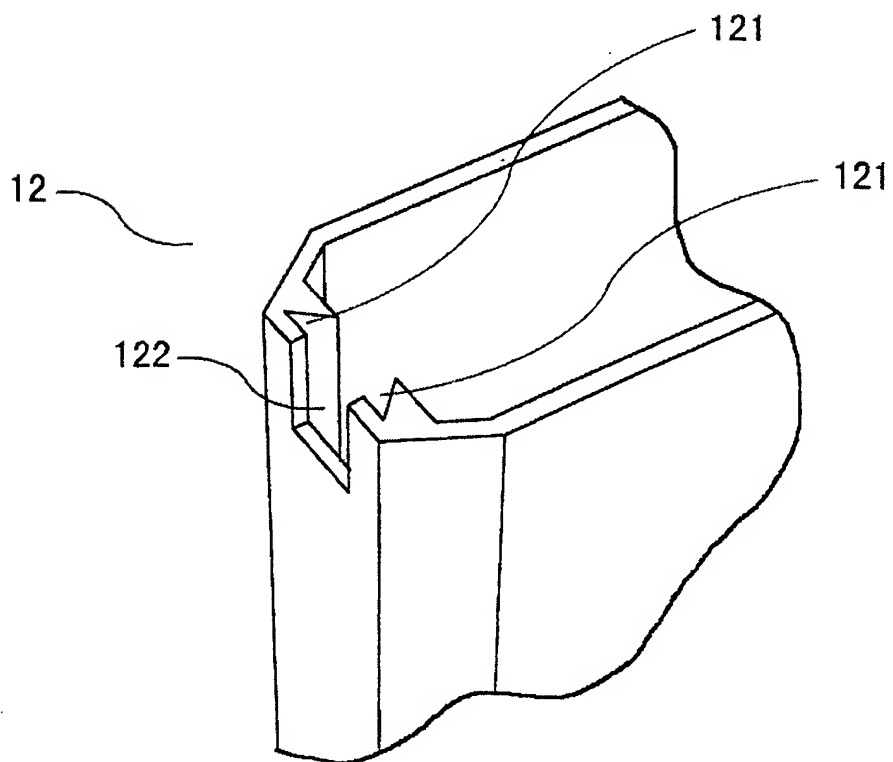


FIG. 4